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Phone (302) 658-9141

LARRY R. LAYCOCK (*pro hac vice application filed*)  
CHAD E. NYDEGGER (*pro hac vice application filed*)  
**WORKMAN NYDEGGER**  
1000 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, UT 84111  
Telephone: (801) 533-9800

Attorneys for Plaintiff  
SUN OPTICS, INC.

UNITED STATES DISTRICT COURT FOR THE  
DISTRICT OF DELAWARE

SUN OPTICS, INC., a Utah Corporation,	)	Civil Action No. 1:07cv137 SLR
Plaintiff,	)	<b>DECLARATION OF CHAD E.</b>
v.	)	<b>NYDEGGER</b>
FGX INTERNATIONAL, INC., a Delaware	)	Oral Argument May 18, 2007 at 9:00 a.m.
Corporation,	)	
Defendant.	)	Filed April 12, 2007
	)	

I, Chad E. Nydegger, hereby state:

1. I am an attorney with the firm of Workman Nydegger, counsel for the Plaintiffs in the above-entitled action.
2. I make this declaration based upon my own personal knowledge, and based upon records maintained by Workman Nydegger in the ordinary course of business, to which I have access in the course of fulfilling my duties for the firm and its clients.

3. Attached hereto as Exhibit A is a true and correct copy of a Preliminary Amendment filed May 24, 2005, regarding Serial No. 29/205,824, the '427 patent.

4. Attached hereto as Exhibit B is a true and correct copy of A Preliminary Amended filed May 24, 2005, regarding Serial No. 29/221,502, the '180 patent.

5. Attached hereto as Exhibit C is a true and correct copy of an Office Action mailed November 18, 2005, regarding Serial No. 29/205,824, the '427 patent.

6. Attached hereto as Exhibit D is a true and correct copy of an Office Action mailed November 18, 2005, regarding Serial No. 29/221,502, the '180 patent.

7. Attached hereto as Exhibit E is a true and correct copy of Amendment "B" and Response to Office Action, filed February 2, 2006, regarding Serial No. 29/205,824, the '427 patent.

8. Attached hereto as Exhibit F is a true and correct copy of Amendment "B" and Response to Office Action, filed February 2, 2006, regarding Serial No. 29/221,502, the '180 patent.

I declare under penalty of perjury under the laws of the United States of America that the statements set forth hereinabove are true and correct to the best of my knowledge and understanding.

DATED this 12th day of April, 2007.

  
\_\_\_\_\_  
CHAD E. NYDEGGER

## **EXHIBIT A**

PATENT APPLICATION  
Docket No: 14301.44

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of )  
                        )  
                        )  
                        Bruce Raile         )  
                        )  
Serial No.:        29/205,824         ) Art Unit  
                        )  
Filed:            May 20, 2004         ) 2913  
                        )  
Confirmation No.: 9949                 )  
                        )  
For:              EYEGLASS CASE         )

PRELIMINARY AMENDMENT

Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Please amend the above-identified application as follows:

**Amendments to the Specification** begin on page 2 of this paper.

**Remarks** begin on page 3 of this paper.

**SPECIFICATION AMENDMENTS**

After Paragraph [001], please insert the following:

**Cross-Reference to Related Application**

[001.1] This application claims priority to United States Patent Application No. 10/360,264, filed on February 6, 2003, entitled EYEWEAR CASE AND DISPLAY METHOD; which claims the benefit of United States Provisional Patent Application No. 60/433,724, filed on December 13, 2002, entitled EYEWEAR CASE AND DISPLAY METHOD; which are incorporated by reference in its entirety.

**REMARKS**

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

DATED this 24 day of May 2005.

Respectfully submitted,



JOHN C. STRINGHAM  
Attorney for Applicants  
Registration No. 40,831  
Customer No. 022913  
Telephone No.: (801) 533-9800

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## **EXHIBIT B**

PATENT APPLICATION  
Docket No: 14301.50

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	)	
	)	
Bruce Raile	)	
	)	
Serial No.:	29/221,502	) Art Unit
		) 2913
Filed:	January 17, 2005	)
		)
Confirmation No.:	6681	)
		)
For:	EYEGLASS CASE	)

PRELIMINARY AMENDMENT

Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Please amend the above-identified application as follows:

**Amendments to the Specification** begin on page 2 of this paper.

**Remarks** begin on page 3 of this paper.

**SPECIFICATION AMENDMENTS**

Please replace Paragraph [001] with the following:

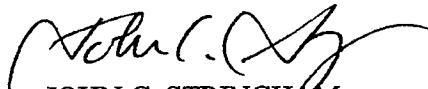
[001] This application claims priority to United States Design Patent Application No. 29/205,824 filed on May 20, 2004, entitled EYEGLASS CASE; and to United States Patent Application No. 10/360,264, filed on February 6, 2003, entitled EYEWEAR CASE AND DISPLAY METHOD; which claims the benefit of United States Provisional Patent Application No. 60/433,724, filed on December 13, 2002, entitled EYEWEAR CASE AND DISPLAY METHOD; which are incorporated herein by reference.

**REMARKS**

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

DATED this 24 day of May 2005.

Respectfully submitted,



JOHN C. STRINGHAM  
Attorney for Applicants  
Registration No. 40,831  
Customer No. 022913  
Telephone No.: (801) 533-9800

W:\14301\50\DFR0000009047V001.DOC

## **EXHIBIT C**



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/205,824	05/20/2004	Bruce Raile	14301.44	9949
22913	7590	11/18/2005	EXAMINER	
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			MURPHY, CELIA A	
			ART UNIT	PAPER NUMBER
			2916	
DATE MAILED: 11/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	29/205,824	RAILE, BRUCE	
	Examiner Celia A. Murphy	Art Unit 2916	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 May 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) The claim is pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) The claim is rejected.
- 7) Claim(s) to priority is/are objected to.
- 8) The claim is subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 May 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
filed: 9/16/2004.
- 4) Interview Summary (PTO-413)  
filed: \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

*Application/Control Number: 29/205,824**Page 2**Art Unit: 2916*

The preliminary amendment claiming priority to a provisional application is objected to. No claim for priority based on a provisional application may be made in a design application.<sup>1</sup>  
***Applicant should cancel his claim to priority.***

For clarity, the descriptions of Fig. 1 should be amended to read:

- **Figure 1 is a perspective view of an EYEGLASS CASE showing my new design; --**

The claim is provisionally rejected under the judicially created doctrine of obviousness-type double patenting of the claim of copending Application No. 29/221,502.

Although the conflicting claims are not identical, they are not patentably distinct from each other because to simply increase or decrease the proportion of the design would be obvious to a person of ordinary skill in the art. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

It is well settled that it is unobviousness in the overall appearance of the claimed design, when compared with the prior art, rather than minute details or small variations in design as appears to be the case here, that constitutes the test of design patentability.<sup>2</sup>

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.<sup>3</sup>

*The references are cited as possible pertinent art.*

*The claim stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting.*

Questions about this communication should be directed to examiner, C. A.

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<sup>1</sup> MPEP 1.53 (c) (4)

<sup>2</sup> See *In re Frick*, 275 F2d 741, 125 USPQ 191 (CCPA 1960) and *In re Lamb*, 286 F2d 610, 128 USPQ 539 (CCPA 1961).

<sup>3</sup> See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Application/Control Number: 29/205,824

Page 3

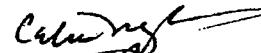
Art Unit: 2916

Murphy, whose telephone number is (571) 272-2654. If attempts to reach the examiner by telephone are unsuccessful, then the examiner's supervisor, I. Simmons can be reached at (571) 272-2658. The Central FAX phone number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Contact the Electronic Business Center, (EBC) toll-free, at 866-217-9197 for answers to questions about access to the Private PAIR system.

Questions about **clerical processing** of should be directed to **Vonda Gale**, the Supervisory applications Examiner, whose telephone number is (571) 272-2578.

C. A. Murphy  
November 4, 2005

  
CELIA MURPHY  
PRIMARY EXAMINER  
ART UNIT 2914

Form PTO-1449

Applicant: Bruce Raile  
 Serial No.: 29/205,824  
 Filing Date: May 20, 2004  
 For: EYEGLASS CASE



Sheet 1 of 2

Att'y Docket No.: 14301.44

INFORMATION DISCLOSURE CITATIONS MADE BY APPLICANT

(modified 1449)

U.S. Patent Documents

<u>Examiner Initial*</u>	<u>Document Number</u>	<u>Issue Date</u>	<u>Name</u>
A1	6,626,287	09/30/2003	Watson
A2	6,415,915	07/19/2002	Grossman
A3	5,929,967	07/27/1999	Conner
A4	5,568,872	10/29/1996	Hinnant, Sr.
A5	5,501,321	03/26/1996	Liu
A6	5,423,419	06/13/1995	Wentz et al.
A7	4,744,461	05/17/1988	Lapham
A8	4,733,775	03/29/1988	Fireman
A9	4,715,575	12/29/1987	Kamerer
A10	4,204,602	05/27/1980	Dunchock
A11	3,817,392	06/18/1974	Bloch
A12	3,357,568	12/12/1967	Leblanc et al.
A13	3,333,709	08/01/1967	Leblanc et al.
A14	2,966,271	12/27/1960	Nadel
A15	2,936,897	05/17/1960	Bloch
A16	RE24,571	11/25/1958	Nadel

Examiner: *Celina M. Murphy*

Date Considered:

11/4/2005

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609, draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Sheet 2 of 2

## Form PTO-1449

Applicant: Bruce Raile  
 Serial No.: 29/205,824  
 Filing Date: May 20, 2004  
 For: EYEGLASS CASE

Att'y Docket No.: 14301.44

U.S. Patent Documents

<u>Examiner Initial*</u>	<u>Document Number</u>	<u>Issue Date</u>	<u>Name</u>
(CRW)	A17 2,816,666	12/17/1957	Nadel
	A18 2,747,760	05/29/1956	Jacobson
	A19 2,735,597	02/21/1956	Treleven
	A20 2,713,947	07/26/1955	Foster

Foreign Patent Documents

<u>Examiner Initial*</u>	<u>Document Number</u>	<u>Publication Date</u>	<u>Country or Patent Office</u>
(CRW)	B1 DE 3815889	11/23/1989	Germany

Other Documents  
(including author, title, pertinent pages, etc.)

Examiner  
Initial\*

NONE

Examiner: CRW Date Considered: 11/24/08

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609, draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<b>Notice of References Cited</b>	Application/Control No.	Applicant(s)/Patent Under Reexamination
	29/205,824	RAILE, BRUCE
	Examiner Celia A. Murphy	Art Unit 2916

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-246,460 A	08-1881	—	206/6
	B	US-2,809,766 A	10-1957	EDDIE ANDERSON	220/326
	C	US-D286,462 S	11-1986	Sender et al.	D3/265
	D	US-D422,139 S	04-2000	Meikle, Howard C.	D3/268
	E	US-D425,299 S	05-2000	Charbonneau, Robert	D3/265
	F	US-6,102,541 A	08-2000	Kuo, Shui-Hua	351/63
	G	US-6,170,651 B1	01-2001	Taormina, David M.	206/5
	H	US-6,206,217 B1	03-2001	Chiang, Herman	220/8
	I	US-D441,953 S	05-2001	Ben Moshe, Dan	D3/265
	J	US-6,273,246 B1	08-2001	Marciano, Moshe	206/301
	K	US-6,382,407 B1	05-2002	Chao, Richard	206/5
	L	US-D467,421 S	12-2002	Chao, David	D3/265
	M	US-6,929,116 B2	08-2005	Chao et al.	206/5

**FOREIGN PATENT DOCUMENTS**

		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

Copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

<b>Notice of References Cited</b>		Application/Control No.	Applicant(s)/Patent Under Reexamination RAILE, BRUCE	
		Examiner Celia A. Murphy	Art Unit 2916	Page 2 of 3

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-D339,913 S	10-1993	Reed, Elmer	D3/265
	B	US-D400,009 S	10-1998	Conway, Gary Roy	D3/265
	C	US-5,899,371 A	05-1999	Weliver, William W.	224/245
	D	US-D432,786 S	10-2000	Rogers, Graham	D3/265
	E	US-D434,560 S	12-2000	Chao, David Yinkai	D3/265
	F	US-D436,725 S	01-2001	Rogers, Graham	D3/265
	G	US-D437,112 S	02-2001	Toffoli, Ruggero	D3/219
	H	US-D439,738 S	04-2001	McCormack, Corinne	D3/265
	I	US-D446,389 S	08-2001	Zhou, Shunkao	D3/265
	J	US-2002/0157968 A1	10-2002	Chen, Chih	206/5
	K	US-6,491,158 B2	12-2002	Chen, Chih	206/5
	L	US-6,851,552 B1	02-2005	Chao, David	206/5
	M	US-2005/0155872 A1	07-2005	Cheng, Hsi-Chou	206/006

**FOREIGN PATENT DOCUMENTS**

		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

Copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

<b>Notice of References Cited</b>	Application/Control No.	Applicant(s)/Patent Under Reexamination RAILE, BRUCE	
	Examiner Celia A. Murphy	Art Unit 2916	Page 3 of 3

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-D432,784 S	10-2000	Conway, Gary Roy	D3/203.5
	B	US-D436,434 S	01-2001	Conway, Gary Roy	D3/203.5
	C	US-D454,686 S	03-2002	McCormack, Corinne	D3/265
	D	US-D483,944 S	12-2003	Conner, William A.	D3/265
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

Copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

## **EXHIBIT D**



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/221,502	01/17/2005	Bruce Railc	14301.50	6681
22913	7590	11/18/2005	EXAMINER	
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			MURPHY, CELIA A	
		ART UNIT		PAPER NUMBER
		2916		
DATE MAILED: 11/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	29/221,502	RAILE, BRUCE
	<b>Examiner</b>	<b>Art Unit</b>
	Celia A. Murphy	2916

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
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- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
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#### Status

- 1) Responsive to communication(s) filed on 27 May 2005.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) The claim is pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) The claim is rejected.  
 7) Claim(s) to priority is/are objected to.  
 8) The claim is subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 1/17/2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
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 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 filed: 04/06/2004 6/6/05
- 4) Interview Summary (PTO-413)  
 filed: \_\_\_\_\_  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

*Application/Control Number: 29/221,502**Page 2**Art Unit: 2916*

The preliminary amendment claiming priority to a provisional application is objected to. No claim for priority based on a provisional application may be made in a design application.<sup>1</sup> ***Applicant should cancel his claim to priority.***

For clarity, the descriptions of Fig. 1 should be amended to read:

- **Figure 1 is a perspective view of an EYEGLASS CASE showing my new design;** --

The claim is provisionally rejected under the judicially created doctrine of obviousness-type double patenting of the claim of copending Application No. 29/205,824.

Although the conflicting claims are not identical, they are not patentably distinct from each other because to simply increase or decrease the proportion of the design would be obvious to a person of ordinary skill in the art. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

It is well settled that it is unobviousness in the overall appearance of the claimed design, when compared with the prior art, rather than minute details or small variations in design as appears to be the case here, that constitutes the test of design patentability.<sup>2</sup>

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.<sup>3</sup>

*The references are cited as possible pertinent art.*

*The claim stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting.*

Questions about this communication should be directed to examiner, C. A.

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<sup>1</sup> MPEP 1.53 (c) (4)

<sup>2</sup> See *In re Frick*, 275 F2d 741, 125 USPQ 191 (CCPA 1960) and *In re Lamb*, 286 F2d 610, 128 USPQ 539 (CCPA 1961).

<sup>3</sup> See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Application/Control Number: 29/221,502

Page 3

Art Unit: 2916

Murphy, whose telephone number is (571) 272-2654. If attempts to reach the examiner by telephone are unsuccessful, then the examiner's supervisor, I. Simmons can be reached at (571) 272-2658. The Central FAX phone number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Contact the Electronic Business Center, (EBC) toll-free, at 866-217-9197 for answers to questions about access to the Private PAIR system.

Questions about **clerical processing** of should be directed to **Vonda Gale**, the Supervisory applications Examiner, whose telephone number is (571) 272-2578.

C. A. Murphy  
November 4, 2005

  
CELIA MURPHY  
PRIMARY EXAMINER  
ART UNIT 2914

Sheet 1 of 27

Form PTO-1449

Applicant: Bruce Raile  
 Serial No.: 29/221,502  
 Filing Date: January 17, 2005  
 For: EYEGLASS CASE

Att'y Docket No.: 14301.50

INFORMATION DISCLOSURE CITATIONS MADE BY APPLICANT (modified 1449)U.S. Patent Documents

<u>Initial*</u>	<u>Document Number</u>	<u>Issue Date</u>	<u>Name</u>
A1	6,626,287	09/30/2003	Watson
A2	6,415,915	07/19/2002	Grossman
A3	5,929,967	07/27/1999	Conner
A4	5,568,872	10/29/1996	Hinnant, Sr.
A5	5,501,321	03/26/1996	Liu
A6	5,423,419	06/13/1995	Wentz et al.
A7	4,744,461	05/17/1988	Lapham
A8	4,733,775	03/29/1988	Fireman
A9	4,715,575	12/29/1987	Kamerer
A10	4,204,602	05/27/1980	Dunchock
A11	3,817,392	06/18/1974	Bloch
A12	3,357,568	12/12/1967	Leblanc et al.
A13	3,333,709	08/01/1967	Leblanc et al.
A14	2,966,271	12/27/1960	Nadel
A15	2,936,897	05/17/1960	Bloch
A16	RE24,571	11/25/1958	Nadel

Examiner:

Date Considered:

*Celinda Ray**6/14/2005*

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609, draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Sheet 2 of 2

## Form PTO-1449

Applicant: Bruce Raile  
 Serial No.: 29/221,502  
 Filing Date: January 17, 2005  
 For: EYEGLASS CASE

Att'y Docket No.: 14301.50

U.S. Patent Documents

<u>Examiner Initial*</u>	<u>Document Number</u>	<u>Issue Date</u>	<u>Name</u>
(CJW) A17	2,816,666	12/17/1957	Nadel
A18	2,747,760	05/29/1956	Jacobson
A19	2,735,597	02/21/1956	Treleven
A20	2,713,947	07/26/1955	Foster

Foreign Patent Documents

<u>Examiner Initial*</u>	<u>Document Number</u>	<u>Publication Date</u>	<u>Country or Patent Office</u>
(CJW) B1	DE 3815889	11/23/1989	Germany

Other Documents  
(including author, title, pertinent pages, etc.)Examiner  
Initial\*

NONE

Examiner: *Celanor* Date Considered: *11/4/2005*

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609, draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<b>Notice of References Cited</b>	Application/Control No.	Applicant(s)/Patent Under Reexamination RAILE, BRUCE
	Examiner Celia A. Murphy	Art Unit 2916      Page 1 of 3

**U.S. PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
A	US-246,460 A	08-1881	-	206/6
B	US-2,809,766 A	10-1957	EDDIE ANDERSON	220/326
C	US-D286,462 S	11-1986	Sender et al.	D3/265
D	US-D422,139 S	04-2000	Meikle, Howard C.	D3/268
E	US-D425,299 S	05-2000	Charbonneau, Robert	D3/265
F	US-6,102,541 A	08-2000	Kuo, Shui-Hua	351/63
G	US-6,170,651 B1	01-2001	Taormina, David M.	206/5
H	US-6,206,217 B1	03-2001	Chiang, Herman	220/8
I	US-D441,953 S	05-2001	Ben Moshe, Dan	D3/265
J	US-6,273,246 B1	08-2001	Marciano, Moshe	206/301
K	US-6,382,407 B1	05-2002	Chao, Richard	206/5
L	US-D467,421 S	12-2002	Chao, David	D3/265
M	US-6,929,116 B2	08-2005	Chao et al.	206/5

**FOREIGN PATENT DOCUMENTS**

	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
N					
O					
P					
Q					
R					
S					
T					

**NON-PATENT DOCUMENTS**

*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages
U	
V	
W	
X	

copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
As in MM-YYYY format are publication dates. Classifications may be US or foreign.

<b>Notice of References Cited</b>		Application/Control No.	Applicant(s)/Patent Under Reexamination RAILE, BRUCE	
		Examiner Celia A. Murphy	Art Unit 2916	Page 2 of 3

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-D339,913 S	10-1993	Reed, Elmer	D3/265
	B	US-D400,009 S	10-1998	Conway, Gary Roy	D3/265
	C	US-5,899,371 A	05-1999	Weliver, William W.	224/245
	D	US-D432,786 S	10-2000	Rogers, Graham	D3/265
	E	US-D434,560 S	12-2000	Chao, David Yinkai	D3/265
	F	US-D436,725 S	01-2001	Rogers, Graham	D3/265
	G	US-D437,112 S	02-2001	Toffoli, Ruggero	D3/219
	H	US-D439,738 S	04-2001	McCormack, Corinne	D3/265
	I	US-D446,389 S	08-2001	Zhou, Shunkao	D3/265
	J	US-2002/0157968 A1	10-2002	Chen, Chih	206/5
	K	US-6,491,158 B2	12-2002	Chen, Chih	206/5
	L	US-6,851,552 B1	02-2005	Chao, David	206/5
	M	US-2005/0155872 A1	07-2005	Cheng, Hsi-Chou	206/006

**FOREIGN PATENT DOCUMENTS**

		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

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copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

<b>Notice of References Cited</b>	Application/Control No.	Applicant(s)/Patent Under Reexamination	
	29/221,502	RAILE, BRUCE	
	Examiner	Art Unit	Page 3 of 3
	Celia A. Murphy	2916	

**U.S. PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
A	US-D432,784 S	10-2000	Conway, Gary Roy	D3/203.5
B	US-D436,434 S	01-2001	Conway, Gary Roy	D3/203.5
C	US-D454,686 S	03-2002	McCormack, Corinne	D3/265
D	US-D483,944 S	12-2003	Conner, William A.	D3/265
E	US-			
F	US-			
G	US-			
H	US-			
I	US-			
J	US-			
K	US-			
L	US-			
M	US-			

**FOREIGN PATENT DOCUMENTS**

	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
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O					
P					
Q					
R					
S					
T					

**NON-PATENT DOCUMENTS**

*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
U	
V	
W	
X	

Copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

## **EXHIBIT E**

VIA FACSIMILE

PATENT APPLICATION  
Docket No. 14301.44

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	)	
	)	
	)	
Bruce Raile	)	
	)	
Serial No.:	29/205,824	) Art Unit
		) 2916
Filed:	May 20, 2004	)
		)
Conf. No.:	9949	)
		)
For:	EYEGLASS CASE	)
		)
Examiner:	Celia A. Murphy	)
		)
Customer No.:	022913	)

AMENDMENT "B" AND RESPONSE TO OFFICE ACTION

**VIA FACSIMILE (571) 273-8300**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated November 18, 2005, please amend the above-identified application as follows:

**Amendments to the Specification** begin on page 2 of this paper.

**Remarks/Arguments** begin on page 3 of this paper.

Application No. 29/221,503  
Amendment "B" and Response to Office Action

**AMENDMENTS TO THE SPECIFICATION**

Please replace Paragraph [001] with the following:

**[001]** This application claims priority to United States Patent Application No. 10/360,264, filed on February 6, 2003, entitled EYEWEAR CASE AND DISPLAY METHOD, which is incorporated herein by reference.

Please replace Paragraph [002] with the following:

**[002]** Figure 1 is a perspective view of an EYEGLASS CASE showing my new design;

Application No. 29/221,503  
Amendment "B" and Response to Office Action

**REMARKS**

This correspondence responds to the Office Action dated November 18, 2005.

**1. PRIORITY CLAIM**

Applicant respectfully requests that the priority claim to United States Provisional Application No. 60/433,724 be cancelled.

**2. NONSTATUTORY DOUBLE PATENTING**

Filed concurrently herewith is a terminal disclaimer, filed in compliance with 37 C.F.R. § 1.321(c), disclaiming the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending reference Application No. 29/221,502, filed on January 17, 2005, as such term is defined in 35 U.S.C. 154 and 173.

**3. CONCLUSION**

In view of the foregoing, Applicant respectfully asserts that this application is in condition for allowance. Reconsideration and favorable action is respectfully requested. Should the Examiner have any questions or concerns which can be resolved by a discussion with the Applicant's attorney or through an Examiner's Amendment, the Examiner is invited to contact the Applicant's attorney by telephone at (801) 533-9800.

Application No. 29/221,503  
Amendment "B" and Response to Office Action

Dated this 2 day of February 2006.

Respectfully submitted,

  
JOHN C. STRINGHAM  
Registration No. 40,831  
Attorney for Applicant

**WORKMAN NYDEGGER**  
**Customer No. 022913**  
**Telephone No. (801) 533-9800**  
[jstringham@wnlaw.com](mailto:jstringham@wnlaw.com)

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## **EXHIBIT F**

VIA FACSIMILE

PATENT APPLICATION  
Docket No. 14301.50

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	)	
	)	
Bruce Raile	)	
	)	
Serial No.:	29/221,502	) Art Unit
		) 2916
Filed:	January 17, 2005	)
		)
Conf. No.:	6681	)
		)
For:	EYEGLASS CASE	)
		)
Examiner:	Celia A. Murphy	)
		)
Customer No.:	022913	)

AMENDMENT "B" AND RESPONSE TO OFFICE ACTION

**VIA FACSIMILE (571) 273-8300**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated November 18, 2005, please amend the above-identified application as follows:

**Amendments to the Specification** begin on page 2 of this paper.

**Remarks/Arguments** begin on page 3 of this paper.

Application No. 29/221,503  
Amendment "B" and Response to Office Action

**AMENDMENTS TO THE SPECIFICATION**

Please replace Paragraph [001] with the following:

**[001]** This application claims priority to United States Design Patent Application No. 29/205,824 filed on May 20, 2004, entitled EYEGLASS CASE; and to United States Patent Application No. 10/360,264, filed on February 6, 2003, entitled EYEWEAR CASE AND DISPLAY METHOD, which are incorporated herein by reference.

Please replace Paragraph [003] with the following:

**[002]** Figure 1 is a perspective view of an EYEGLASS CASE showing my new design;

Application No. 29/221,503  
Amendment "B" and Response to Office Action

**REMARKS**

This correspondence responds to the Office Action dated November 18, 2005.

**1. PRIORITY CLAIM**

Applicant respectfully requests that the priority claim to United States Provisional Application No. 60/433,724 be cancelled.

**2. NONSTATUTORY DOUBLE PATENTING**

Filed concurrently herewith is a terminal disclaimer, filed in compliance with 37 C.F.R. § 1.321(c), disclaiming the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending reference Application No. 29/205,824, filed on May 20, 2004, as such term is defined in 35 U.S.C. 154 and 173.

**3. CONCLUSION**

In view of the foregoing, Applicant respectfully asserts that this application is in condition for allowance. Reconsideration and favorable action is respectfully requested. Should the Examiner have any questions or concerns which can be resolved by a discussion with the Applicant's attorney or through an Examiner's Amendment, the Examiner is invited to contact the Applicant's attorney by telephone at (801) 533-9800.

Application No. 29/221,503  
Amendment "B" and Response to Office Action

Dated this 2 day of February 2006.

Respectfully submitted,

  
JOHN C. STRINGHAM  
Registration No. 40,831  
Attorney for Applicant

**WORKMAN NYDEGGER**  
**Customer No. 022913**  
**Telephone No. (801) 533-9800**  
jstringham@wnlaw.com

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**UNITED STATES DISTRICT COURT FOR THE  
DISTRICT OF DELAWARE**

SUN OPTICS, INC. )  
a Utah Corporation, )  
                      )  
                      Plaintiff, )  
                      )  
                      )  
v.                   ) Civil Action No.07-137 (SLR)  
                      )  
                      )  
FGX INTERNATIONAL, INC., )  
a Delaware Corporation, )  
                      )  
                      Defendant. )

**CERTIFICATE OF SERVICE**

I, R. Eric Hutz, hereby certify that on April 12, 2007, I caused to be electronically filed a true and correct copy of the foregoing with the Clerk of the Court using CM/ECF, which will send notification that such filing is available for viewing and downloading to the following counsel of record:

Donald J. Detweiler, Esquire (I.D. 3087)  
Sandra G. M. Selzer (I.D. 4283)  
**GREENBERG TRAURIG, LLP**  
The Nemours Building  
1007 North Orange Street  
Suite 1200  
Wilmington, DE 19801  
*Attorney for Defendant*  
*FGX International Inc.*

/s/ R. Eric Hutz